

REMARKS

This is in response to the final Office Action mailed November 17, 2008. Claims 11-13 are pending and rejected.

In view of the following discussion, Applicants submit that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103. Thus, Applicants believe that all of these claims are now in allowable form.

It is to be understood that Applicants do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant response.

Applicants traverse all of the rejections in the non-final Office Action and respectfully request reconsideration and passage of the claims to allowance for the following reasons.

I. REJECTION OF CLAIMS 11-13 UNDER 35 U.S.C. §103

A. Claim 11

The Examiner has rejected claim 11 under 35 U.S.C. §103 as being unpatentable over Hendricks et al. (5,600,573, hereinafter "Hendricks") in view of Kenner et al. (5,956,716, hereinafter "Kenner"), Campanella (5,864,546, hereinafter "Campanella"), Farry et al. (5,608,447, hereinafter "Farry") and Hoarty (5,485,197, hereinafter Hoarty). Applicants traverse the rejection.

The Examiner responds to the Applicants' previous arguments stating that the Applicants' arguments would only be relevant to the instant application if the Campanella, Farry or Hoarty references were actually being modified in view of each other. (See Final Office Action, p. 2, § 1). The Applicants note that the Examiner is applying an obviousness rejection against the Applicants' claims using the combination of Hendricks, Kenner, Campanella, Farry and Hoarty.

In doing so the Examiner is required to consider the prior art in its entirety. "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention". MPEP § 2141.02(VI), W.L. Gore &

Associates, Inc., v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed Cir. 1983), cert. denied, 469 U.S. 851 (1984)(emphasis added). It is impermissible to use the claims as a framework from which to choose among individual references to recreate the claimed invention. W. L. Gore Associates, Inc. v. Garlock, Inc., 220 U.S.P.Q. 303, 312 (1983). (See MPEP §2141.02(VI)).

Thus, when all of the references are viewed in their entirety, the teachings of Campanella, Farry and Hoarty would render the combination inoperable. The Examiner cites the highly relevant and correct section of the MPEP 2143.01 that states “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) MPEP 2143.01(V).

In view of the above relevant case law and appropriate sections of the MPEP, the Applicants respectfully submit that the combination of Hendricks, Kenner, Campanella, Farry and Hoarty fails to render obvious Applicants’ invention because Campanella, Farry and Hoarty cannot be meaningfully combined. Combining the teachings of Campanella with Farry or Hoarty would render Farry and Hoarty inoperable.

Campanella teaches a system for formatting broadcast data for satellite transmission and radio reception. Uplink signals generated from the broadcast stations are modulated in frequency division multiple access (FDMA) channels from the ground stations. (See Campanella, col. 3, ll. 46-50). In other words, Campanella uses multiple frequencies for broadcast transmission.

Hoarty teaches that communications between a node and the subscriber home occurs as a compressed digital data stream on a time-shared basis or as addressed packets. (See Hoarty, col. 9, ll. 53-65). In other words, Hoarty teaches using a TDM communication signal or digitally addressed packets. In other words, instead of using separate carriers at separate frequencies, as taught by Campanella, Hoarty teaches using a single compressed digital data stream on a time-shared basis or as addressed packets. Therefore, the FDMA signals used by Campanella would render the communications in Hoarty inoperable.

Moreover, Campanella teaches that the broadcast stations are configured to use frequency bands of 1467 to 1492 Megahertz (MHz) and uplinks from 7050 to 7075 MHz. (See Campanella, col. 3, ll. 31-45). In stark contrast, Hoarty teaches the operations of channels within 72-76 MHz and uplink channels within the 15-18 MHz region. (See Hoarty, col. 9, ll. 46-50). Thus, the operating frequency range of Campanella would also be in operable if combined with the teachings of Hoarty.

Moreover, the combination of Campanella with Farry would render the operation of Farry inoperable. Farry teaches the communication between an information service provider and a particular subscriber end device via a virtual circuit through ATM switches. (See Farry, col. 7, ll. 15-22; FIG. 11). The ATM network taught by Farry uses TDM techniques. (See *Id.* at col. 5, ll. 8-10).

As discussed above, unlike Farry's video distribution network that uses TDM techniques, Campanella teaches that the broadcast stations use FDM techniques. Thus, if Campanella and Farry were combined, the FDM techniques used by the broadcast stations of Campanella would render inoperable Farry's video distribution network that uses TDM techniques in an ATM network.

Therefore, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness against Applicants' claims because Campanella, Hoarty and Farry cannot be meaningfully combined. Moreover, Hendricks and Kenner fail to teach or suggest all of the claim limitations as positively recited by independent claim 11. Therefore, Applicants submit that independent claim 11 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Therefore, Applicants respectfully request that the rejection be withdrawn.

B. Claims 12-13

The Examiner has rejected claims 12-13 under 35 U.S.C. §103(a) as being unpatentable over Hendricks, Kenner, Campanella, Farry and Hoarty as applied to claim 11 above, and further in view of Wilkins (5,446,919, hereinafter "Wilkins").

Each of the grounds of rejection applies only to dependent claims, and each is predicated on the validity of the rejection under 35 U.S.C. §103 for independent claim 11. Since the rejection of the independent claim 11 under 35 U.S.C. §103 has been

overcome, as described hereinabove, and there is no argument set forth by the Office Action that any other additional references supply that which is missing from Hendricks, Kenner, Campanella, Farry and Hoarty to render the independent claim 11 unpatentable, these grounds of rejection cannot be maintained. Accordingly, these dependent claims also are non-obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, Applicants respectfully request that the rejection be withdrawn.

CONCLUSION

Thus, Applicants respectfully submit the pending claims are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall or Jimmy Kim at (732) 842-8110 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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